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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN J. HARRINGTON

Appeal 2009-002726
Application 10/669,904
Technology Center 2100

Decided: January 26, 2010

Before JOSEPH L. DIXON, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant appeals the rejection of claims 1 and 23 under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal generally relates to a method for handling and managing desktop icons, and more particularly, method for a graphical user interface for enabling icons to be grouped together or otherwise collected together (Spec. 1).

The Illustrative Claim

Claim 1, an illustrative claim, reads as follows:

> 1. A method for managing a plurality of opened documents being displayed on an electronic desktop of an electronic device, an opened document being an application invoked created area on the electronic desktop of the electronic device, the opened document displaying the contents of an electronic file, comprising:
>
> (a) displaying a first icon associated with a first opened document in a predetermined form;
>
> (b) displaying a second icon associated with a second opened document in the predetermined form;
>
> (c) displaying a third icon associated with a third opened document in the predetermined form;

(d) selecting the first icon associated with the first opened document being displayed on the electronic desktop of the electronic device;

(e) placing the first icon associated with the first opened document onto the second icon associated with the second opened document;

(f) modifying an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document;

(g) displaying a virtual pile icon representing a virtual pile when the first icon is placed onto the second icon, the virtual pile icon having an appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document thereunder;

(h) selecting the third icon associated with the third opened document being displayed on the electronic desktop of the electronic device;

(i) placing the third icon associated with the third opened document onto the virtual pile icon;

(j) modifying an appearance of the third icon associated with the third opened document to display a second single line segment when the third icon associated with the third opened document is placed onto the virtual pile icon; and

(k) modifying the appearance of the virtual pile icon, the virtual pile icon having the appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened

document and the second single line segment representing the third icon associated with the third opened document thereunder.

The References

The Examiner relies on the following references as evidence:

Mander	US 6,243,724 B1	June 5, 2001
Czerwinski	US 2004/0066414 A1 (effectively filed May 23, 2003	Apr. 8, 2004

The Rejections

The following rejections are before us for review:

Claims 1 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Czerwinski in view of Mander.

II. ISSUE

Has the Appellant shown that the Examiner erred in identifying that the combination of Czerwinski and Mander teaches and fairly suggests "modifying an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document," as recited in independent claim 1?

III. PRINCIPLES OF LAW

Prima Facie Case of Unpatentability

The allocation of burden requires that the United States Patent and Trademark Office (USPTO) produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). Appellant has the burden on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

Claim Interpretation

The claim construction analysis begins with the words of the claim. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC. v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003).

"Giving claims their broadest reasonable construction 'serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.'" *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)). "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and

unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." *Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989). "Construing claims broadly during prosecution is not unfair to the applicant . . . because the applicant has the opportunity to amend the claims to obtain more precise claim coverage." *American Academy,* 367 F.3d at 1364.

Obviousness

"Obviousness is a question of law based on underlying findings of fact." *In re Kubin*, 561 F.3d 1351, 1355 (Fed. Cir. 2009). The underlying factual inquiries are: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, (3) the level of ordinary skill in the pertinent art, and (4) secondary considerations of nonobviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

IV. FINDINGS OF FACT

The following findings of fact (FFs) are supported by a preponderance of the evidence.

Czerwinski

1. Czerwinski discloses a graphical user interface for manipulating the group of icons by changing the appearance of an icon while adding or deleting an icon from the group:

> FIG. 3 is a block diagram of the graphical user interface 100 of FIG. 2 illustrating the manipulation of control tiles and

> control tile groups utilizing drag and drop functionality. In one aspect, *guide sets may be displayed on the graphical user interface 100 to indicate whether a selected control tile will be included in a group of control tiles*. As illustrated in FIG. 3, *if a user wished to include control tile 122 into group 126, guide sets, such as curved caret 130, would indicate where a user could release the selected control tile and have it included in the group.* In another aspect, the guide sets may also be used to facilitate the removal of a control tile from a group. As illustrated in FIG. 3, if a user wished to remove control tile 118 from the group 126, *guide sets, such as a straight line 132*, would indicate when a user could release the selected control tile such that the control tile would no longer be included in an adjacent group. *One skilled in the relevant art will appreciate that additional or alternative guide sets may be utilized to facilitate user manipulation* (emphasis added).

(¶[0038], Fig. 3.)

Mander

2. Mander discloses a graphical user interface for organizing files in a computer system that includes piling multiple documents (more than two) to create a new pile and using multiple line segments to illustrate the icons within the pile except the top icon. (Fig. 3, 11a and 11b, col. 8 l. 37-col. 9 l. 43; col. 18 ll. 33-65).

V. ANALYSIS

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If

that burden is met, the burden of coming forward with evidence or argument shifts to the applicant." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The Examiner sets forth a detailed explanation of a prima facie case of unpatentability in the Examiner's Answer. Therefore, we look to the Appellant's Briefs to show error in the proffered prima facie case.

35 U.S.C. § 103(a) rejections

With respect to claim 1, the Appellant contends that "[a]lthough Czerwinski et al. teaches the creation of a group icon, the individual icons, which created the group, are not modified in appearance, but remain unchanged." (App. Br. 8, Reply Br. 4). The Appellant further contends that neither the teachings of Czerwinski or Mander meets the argued limitation, nor does the combination of Czerwinski and Mander. (Reply Br. 9-10.) In particular, Czerwinski "teaches the creation of a group icon, the individual icons, which created the group, are not modified in appearance, but remain unchanged." (*Id.* at 4.) Mander teaches that at least two orthogonal line segments which are used to illustrate a partially covered document. Thus Mander does not suggest the claimed limitation of modifying "an appearance of the icon to display a single line segment when the icon is placed into the pile." (*Id.* at 7.)

We disagree with the Appellant's contentions. We start our analysis with claim construction. We broadly yet reasonably construe the claim limitation "display a single line segment" as displaying any single line segment including multiple single line segments because there is no

limitation "only display a single line segment" in the claim language to prevent us from reading the language broadly. We find Czerwinski teaches that an appearance of an icon 122 or 118 is changed to either a curved line segment 130 or a straight line segment 132, respectively, depending on whether or not the icon is added in the icon group or removed from the icon group (FF 1). We also find Mander teaches moving multiple files (more than two) into pile to create a new pile, and utilizing straight line segments to illustrate the hidden files in the pile (FF 2). Under our claim construction, utilizing more than one line segments still reads on the limitation of claim 1 of "a single line segment." The Supreme Court noted that an obviousness analysis "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S., at 418. The knowledge that adding more than two files into a pile is a desirable way to create a new pile or utilizing line segments either a curved or straight segment to illustrate the hidden files would have been within the skill in the art, as evidenced by Czerwinski and/or Mander. Furthermore, one of ordinary skill in the art is also a person of ordinary creativity, not an automaton. *KSR,* 550 U.S., at 421. It would have been prima facie obvious at the time the invention was made to use the prior art of creating new pile by adding more than two files and utilizing straight line segments to illustrate the hidden files of Mander, and would predictably increase the efficiency of creating a representation of a new pile, a result that both Czerwinski and Mander teach to be desirable. We, therefore, find that

combining the well-known elements of creating a new pile of icons by adding an icon to the pile and using curved line segment to illustrate the added hidden files of Czerwinski with the well-known technique of adding more than two files into the created pile and utilizing straight line segments to illustrate the hidden files in the pile taught by Mander is nothing more than a "predictable use of prior art elements according to their established functions." *KSR*, 550 U.S., at 417.

Accordingly, we sustain the Examiner's obviousness rejection of claim 1. We also sustain the Examiner's obviousness rejection of its dependent claim 23, which has not been separately argued, falls with its base claims. 37 C.F.R. § 41.37 (c)(1)(vii). *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

VI. CONCLUSION

We conclude that the Appellant has not shown that the Examiner erred by failing in identifying that the combination of Czerwinski and Mander teaches and fairly suggests "modifying an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document," as recited in independent claim 1.

VII. ORDER

We affirm the obviousness rejection of claims 1 and 23 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136 (a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rwk

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